

REMARKS/ARGUMENTS

The Office Action mailed December 12, 2008, has been received and reviewed. Claims 1-21 are currently pending in the application. Claims 1-21 stand rejected. Applicant has amended claim 21, and respectfully requests reconsideration of the application as amended herein. No new matter has been added.

35 U.S.C. § 101 Rejection

Claim 21 stands rejected under 35 U.S.C. § 101, asserting that the claimed invention is directed to non-statutory subject matter. Applicant respectfully traverses this rejection, as hereinafter set forth.

The Office Action states:

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing concrete, useful, and tangible result to form the basis of statutory matter under 35 USC 101.

Although support is shown in the specification, which discloses that “a software module may reside in RAM memory, flash memory, ROM memory, EPROM memory, EEPROM memory, registers, hard disk, a removable disk, a CD-ROM, or any other form of storage medium known in the art” (paragraph 77), claim 21 is completely silent where the software module may reside. (Office Action, p. 2; emphasis added).

Applicant has amended claim 21 to recite, *inter alia*, “Processor readable ***media encoded thereon with*** processor-executable ***instructions for causing a processor to perform*** the following steps.” Applicant has deleted “software module” from claim 21 and Applicant respectfully notes that claim 21 is a media-based claim and is not required to recite the location or “where the ... software module may reside.” Accordingly, Applicant respectfully requests the rejection of claim 21 under 35 U.S.C. §101 be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Amerga in view of Bamburak

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. US 2003/0231605 to Amerga ("Amerga") in view of U.S. Patent Publication No. US 2004/0219915 to Bamburak *et al.* ("Bamburak ").

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have

prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-21 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

The Office Action concedes:

Amerga fails to specifically disclose generating a frequency switch blocking signal ***to override opening the serving cell transceiving gap for searching outside of the serving cell*** and a frequency controller for generating frequency switch commands, receiving the frequency switch blocking signal, and suppressing the generation of frequency switch commands when the frequency switch blocking signal is asserted. (Office Action, pp. 3-4; emphasis added).

The Office Action then alleges:

Bamburak discloses generating a frequency switch blocking signal ***to override opening the serving cell transceiving gap for searching outside of the serving cell*** (read as undesirable or prohibited SOC(s) or SID(s) or if the user enters an override command) and a frequency controller for generating frequency switch commands, receiving the frequency switch blocking signal, and suppressing the generation of frequency switch commands when the frequency switch blocking signal is asserted. (***paragraph 27***, figure 5 and paragraph 33; figure 9; A search schedule is downloaded using a master search schedule. When downloading the search schedule, frequency bands previously searched are removed from the downloaded schedule to avoid searching bands that have already been searched.) (Office Action, p. 4; emphasis added).

Applicant respectfully asserts that Bamburak **cannot** disclose “***to override opening the serving cell transceiving gap for searching outside of the serving cell***” as alleged in the Office Action since Bamburak does **not** teach a “gap” as claimed by Applicant which could be overridden or blocked as claimed by Applicant. Specifically, Bamburak fails to teach of a communication situation, timing, or any arrangement wherein a serving cell or other entity enters

a planned suspension of transceiving (i.e., “gap”) during which any “searching outside of the serving cell” could be performed.

Specifically, Bamburak teaches:

If the communication device ***cannot lock onto*** the last ACC (Para. [0027], lines 12-13; emphasis added).

[I]f a ***lock is not obtained***, a predetermined search schedule is executed (Para. [0027], lines 19-20; emphasis added).

[T]he search ***pointer*** that identifies the band being searched ***is advanced to identify the next band in the schedule for searching***. (Para. [0027], lines 82-84; emphasis added).

Bamburak clearly teaches that searching advances when a “lock” is unattainable or when some execution “pointer” increments. Furthermore, Bamburak does not appear to teach any performance of steps once the device has arrived at a ‘serving cell.’ Therefore, Bamburak could not teach of “searching outside of the serving cell” as alleged.

Furthermore, Bamburak is silent regarding any type of “transceiving gap” wherein “searching outside the serving cell” could occur. Applicant’s independent claims 1, 13, 14, 17, 20 and 21 each recite, in part, “[frequency switch blocking signal/suppressing frequency switches during the scheduled search] to override opening ***the serving cell transceiving gap for searching outside of the serving cell***” which is conceded as not being taught in Amerga. (Office Action, pp. 3-4). Clearly, Bamburak is void of any teaching of a “transceiving gap” as defined in Applicant’s specification which recites, in part,

[1005] ... gaps in transmission and reception on a serving frequency

[1019] ... gaps are introduced during which reception and transmission are stopped so that the mobile station may switch frequencies or radio access technologies to make measurements, without losing data transmission from or to the serving cell.

Therefore, since neither Amerga nor Bamburak teach or suggest Applicant’s claimed invention including “***to override opening the serving cell transceiving gap for searching outside of the serving cell***”, these references, either individually or in any proper combination, **cannot** render obvious, under 35 U.S.C. §103, Applicant’s invention as presently claimed in independent claims 1, 13, 14, 17, 20 and 21. Accordingly, Applicant respectfully requests the rejection of independent claims 1, 13, 14, 17, 20 and 21 be withdrawn.

The nonobviousness of independent claim 1 precludes a rejection of claims 2-12 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also

MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 1 and claims 2-12 which depend therefrom.

The nonobviousness of independent claim 14 precludes a rejection of claims 15 and 16 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 14 and claims 15 and 16 which depend therefrom.

The nonobviousness of independent claim 17 precludes a rejection of claims 18 and 19 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 17 and claims 18 and 19 which depend therefrom.

Finality of Next Office Action Precluded

Applicant has traversed the prior art rejections of claims 1-21 by argument and not amendment. Therefore, **the finality of the next office action would be improper** as Applicant is entitled to an examination on the merits and to amend as a matter of right. In the present Office Action, Applicant's amendment to independent claim 21 was for addressing a statutory subject matter wording of the preamble and Applicant's independent claims 1, 13, 14, 17 and 20 were not amended.

In the present Office Action, Applicant's independent claims 1, 13, 14, 17, 20 and 21 were not completely examined as to **all** of the elements. Accordingly, Applicant submits that this omission to examine all elements of Applicant's claimed invention amounts to a failure to articulate a *prima facie* case of unpatentability. Consequently, a next office action cannot properly be made final since the present Office Action has not set forth a *prima facie* case. (MPEP § 706.07(a)).

CONCLUSION

In light of the amendments contained herein, Applicant submits that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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